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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,498	03/29/2004	Gerald Duhamel	14296-28US CMB/clb	8902
31831 7590 07/26/2007 LABTRONIX CONCEPT INC. C/O OGILVY RENAULT 1981 MC GILL COLLEGE AVENUE SUITE 1600 MONTREAL, QUEBEC, H3A 2Y3 CANADA			EXAMINER LEE, BENJAMIN WILLIAM	
			ART UNIT 3714	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/811,498	Applicant(s) DUHAMEL ET AL.	
	Examiner Benjamin W. Lee	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 05/17/2007 has been entered. Claims 1-21 are pending in this application. Claims 1 and 18-20 have been amended. Claim 21 is new.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claim 19-21: The claims are directed toward computer programs. The computer programs are "adapted to" perform the steps recited in the bodies of the respective claims (i.e. gather occurrences, display, and trigger). However, the language "adapted to" does not limit the scope of the claim. See MPEP § 2111.04. As such, the bodies of the claims are considered intended use and the steps are only optionally required to be performed. Since the steps are optional, the claims only recite a computer program having codes. The claimed computer program neither provides a physical transformation nor a useful, concrete, and tangible result. Therefore, the claims are directed toward non-statutory subject matter. The examiner suggests replacing the "adapted to" intended use language to --when executed by a computer, cause said computer to-- as was used by applicant in claim 21.

Re claim 20: The claim is directed toward a computer program embodied on an electrical or electro-magnetic carrier signal. A computer program *per se* is nonstatutory. See MPEP § 2106.01(I). A computer program may only be part of a statutory claim when the computer program is structurally and functionally interrelated to a physical, tangible computer medium. An electrical or electro-magnetic carrier signal is a nonstatutory natural phenomenon.

Re claim 21: The claim is directed toward a computer program *per se*. The preamble of the claim includes a computer, but the computer directed toward intended use (“adapted to” indicates intended use). Thus, the claimed computer program is not on a computer-readable medium so as to be structurally and functionally interrelated to the medium and permit the function of the descriptive material to be realized. Therefore, the claim is directed toward non-statutory subject matter. See MPEP § 2106.01(I).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A single means claim (a claim where a means recitation does not appear in combination with another recited element of means) is subject to an undue breadth rejection. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

Claims 19-21 each recite a single element (i.e. a computer program). The bodies of the respective claims are considered intended use since the transitional phrase is "adapted to." It is noted that in the specification the computer program is used for playing a game featuring evolving symbols, and the scope of the claimed computer program (the only means in the claim) covers every conceivable structure for achieving the stated property (a computer program (carried/embodied on a computer-readable medium or electrical/electromagnetic signal having codes). Thus, the claim is held non-enabling since the specification discloses at most only those structures known to the inventor.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Englman (US 2003/0157978) in view of Bennett (US 6,056,642).

Re claims 1: Englman discloses a method of operating a game comprising the steps of displaying a line game/slot game (see Fig. 1; ¶ [0024], lines 5-6) and operating a meter displayed as different statuses of an evolving symbol (see Figs. 8-10; ¶ [0039]; ¶ [0040]) and triggering a feature based on at least one of the statuses. The PLANT symbol 77 enhances (e.g. doubles) a winning combination (see ¶ [0040]).

However, Englman fails to disclose at least three different statuses of an evolving symbol.

Bennett teaches color changing symbols. The symbols feature at least three different colors/statuses (e.g. red, white, and blue, see abstract). At least one of the statuses (red 7's) triggers a feature (a jackpot, see abstract).

Therefore, in view of Bennett, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add additional symbol statuses to the method and system of Englman in order to alter the payout and jackpot rates.

Re claim 2: The teachings of Englman as modified by Bennett as applied to claim 1 have been discussed above. Englman further discloses the meter is used to gather occurrences of a predetermined combination of symbols (see ¶ [0039]).

Re claim 3: The teachings of Englman as modified by Bennett as applied to claim 2 have been discussed above. Englman further discloses the event dependent of the game outcome is a winning outcome (see ¶ [0039]).

Re claim 5: The teachings of Englman as modified by Bennett as applied to claim 1 have been discussed above. Englman further discloses the evolving symbol occurs on a reel (see Figs. 8-10; ¶ [0040]), each occurrence of the evolving symbol comprising an Evolving Symbol Unit (ESU).

Re claim 8: The teachings of Englman as modified by Bennett as applied to claim 5 have been discussed above. Englman further discloses only a portion of the ESUs evolve upon occurrence of an evolution trigger (see Figs. 8-10; ¶ [0040]).

Re claim 9: The teachings of Englman as modified by Bennett as applied to claim 8 have been discussed above. Englman further discloses the evolution trigger occurs when the meter reaches a predetermined threshold (see ¶ [0039]; ¶ [0040]).

Re claim 15: The teachings of Englman as modified by Bennett as applied to claim 1 have been discussed above. Englman further discloses the feature triggered in the game by the evolving symbol is a change is a bonus payout. The enhanced PLANT symbol is used to a multiplier for a winning combination along the same pay line (see ¶ [0040]).

Re claim 17: The teachings of Englman as modified by Bennett as applied to claim 15 have been discussed above. Englman further discloses the evolving symbol occurs on a reel (see Figs. 8-10; ¶ [0040]), each occurrence of the evolving symbol comprising an Evolving Symbol Unit (ESU) and wherein at least one of the ESUs evolve upon occurrence of an evolution trigger (see Figs. 8-10; ¶ [0040]).

Re claim 18: Englman discloses a meter/system memory 22 for gathering occurrences of a predetermined event (see ¶ [0027]), a game apparatus comprising a display controller for displaying the meter as different statuses of an evolving symbol, according at least in part to a value of the meter (see Figs. 1 and 2; ¶ [0026]), an evaluation means for triggering a feature in a line game (see ¶ [0027]; ¶ [0039]), and an evaluation means triggering a feature in a line game based on at least one of the statuses (see ¶ [0039]).

However, Englman fails to disclose at least three different statuses of an evolving symbol.

Bennett teaches color changing symbols. The symbols feature at least three different colors/statuses (e.g. red, white, and blue, see abstract). At least one of the statuses (red 7's) triggers a feature (a jackpot, see abstract).

Therefore, in view of Bennett, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add additional symbol statuses to the method and system of Englman in order to alter the payout and jackpot rates.

Re claims 19-21: The teachings of Englman as modified by Bennett as applied to claim 1 have been discussed above. Englman further discloses the method is performed by a computer program embodied on a computer-readable storage medium or electrical or electromagnetic carrier signal having codes/software (see Fig.2; ¶ [0026]; ¶ [0027]).

9. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Englman as modified by Bennett as applied to claim 2 above, and further in view of Singer et al. (US 6,604,740 B1, hereinafter Singer).

The teachings of Englman as modified by Bennett as applied to claims 2 and 15 have been discussed above.

However, the teachings of Englman as modified by Bennett fail to disclose the event independent of the game outcome is at least one of a spin, an elapsed length of time, and a bet value.

Singer discloses a slot machine game having selectable wild symbols. A set of symbols is changed (i.e. triggered to evolve) to wild symbols based on a spin (there are three selectable spin buttons that designate which set of symbols to use as wild symbols, see abstract; Fig. 4).

Therefore, in view of Singer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the event independent of the game outcome a spin in order to allow the special (evolving) symbols used in the game to change between games.

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10. Claims 6, 7, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Englman as modified by Bennett as applied to claims 5 and 8 above, and further in view of Kaminkow (US 6,780,109 B2).

Re claim 6: The teachings of Englman as modified by Bennett as applied to claim 5 have been discussed above. The applicant has submitted that Englman teaches all ESUs evolve upon occurrence of an evolution trigger (see pages 12-13 of applicant's remarks filed 05/17/2007).

Re claim 7: The teachings of Englman as modified by Bennett as applied to claim 6 have been discussed above. Englman further discloses the evolution trigger occurs when the meter reaches a predetermined threshold (see ¶ [0039]; ¶ [0040]).

Re claim 10: The teachings of Englman as modified by Bennett as applied to claim 8 have been discussed above.

However, Englman fails to disclose or fairly suggest the number of evolving ESUs is randomly selected.

Kaminkow teaches the number of transformable wild symbols that change states is randomly selected (see col. 10, lines 17-28).

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to evolve a random number of ESUs in order to provide another source of unpredictability and chance to the game and thus increase a player's interest in the game.

Re claim 11: The teachings of Englman as modified by Bennett as applied to claim 8 have been discussed above.

However, Englman fails to disclose or fairly suggest the evolving ESUs are randomly selected.

Kaminkow teaches the transformable wild symbols are randomly selected for changing states (see col. 9, line 66 - col. 10, line 9).

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to randomly select ESUs for evolution in order to provide another source of unpredictability and chance to the game and thus increase a player's interest in the game.

Re claim 12: The teachings of Englman as modified by Bennett as applied to claim 8 have been discussed above.

However, Englman fails to disclose or fairly suggest the evolving ESUs are those displayed when the evolution trigger occurs.

Kaminkow teaches an activator symbol that may activate displayed transformable wild symbols (see col. 10, lines 17-28).

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to evolve displayed ESUs when the evolution trigger occurs in order to prevent the probability of a player winning the game from growing to large.

Re claim 13: The teachings of Englman as modified by Bennett as applied to claim 5 have been discussed above. The applicant has submitted that Englman teaches all ESUs evolve at the same rate (see pages 12-13 of applicant's remarks filed 05/17/2007).

Re claim 14: The teachings of Englman as modified by Bennett as applied to claim 5 have been discussed above.

However, Englman fails to disclose or fairly suggest each evolving ESU evolves independently.

Kaminkow teaches the transformable wild symbols are randomly selected for changing states (see col. 9, line 66 - col. 10, line 9). Each random determination of the transformable wild symbol is carried out independently.

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to have all the ESUs evolve independently in order to increase the complexity of game and make the game more interesting to the player.

Response to Arguments

11. Applicant's arguments filed 05/17/2007 have been fully considered but they are not persuasive.

Regarding the applicant's arguments of the rejections of claim 19 under 35 U.S.C. 101, the examiner notes that the previous rejection was not due to the computer program being

embodied on a computer-readable medium but rather that the computer program did not result in a useful, concrete, and tangible result. However, a new ground for the rejection of claim 19 under 35 U.S.C. 101 has been found and is presented above.

Regarding the applicant's arguments of the rejections of claim 20 under 35 U.S.C. 101, the examiner respectfully disagrees. The applicant is correct in noting that a computer-readable medium comprising a computer program that is structurally and functionally related to the invention is statutory. A computer program *per se* is nonstatutory, but the embodiment of a computer program that enables the functionality of an otherwise statutory invention (i.e. a computer-readable medium) is statutory. In this case, an electromagnetic signal is a nonstatutory invention and therefore a computer program embodied on an electromagnetic signal is also a nonstatutory invention.

The claims previously rejected under 35 U.S.C. 102 are now rejected under 35 U.S.C. 103 due to the addition of the claim limitation "at least three different statuses" and are explained above. The examiner respectfully disagrees with the applicant's additional arguments regarding the Engلمان reference. Regarding the argument at the last paragraph 10 to the first paragraph of page 11 of applicant's remarks filed 05/17/2007, it is noted that the features upon which applicant relies (i.e., further occurrences of the trigger causing the evolution of the evolving symbol have an effect in the invention) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Similarly, the applicant's arguments regarding an Evolving Symbol Unit in claim 5 describe limitations that are not claimed. In claim 5, and Evolving Symbol Unit is simply treated as a

single occurrence of an evolving symbol since there are no further limitations. There is no indication in claim 5 that ESUs must evolve independently.

Regarding the applicant's arguments of the rejection of claim 18 (page 12 of applicant's remarks filed 05/17/2007) under the cited prior art, the examiner respectfully disagrees. A meter is used to measure a quantity. In this case, the quantity is some evolution trigger, such as the occurrence of a combination of symbols. Englman teaches that the PLANT symbol counts at least one occurrence of three watering cans and the PLANT symbol evolves (i.e. grows) when the meter value is 1 (one occurrence of three watering cans). The applicant is correct in noting that further occurrences of three watering cans may not be counted, but under this situation the meter may be considered "full." There is no limitation in the claim that indicates that the meter must count more than one occurrence of an evolution trigger.

Applicant's arguments, see page 12 of remarks, filed 05/17/2007, with respect to the rejection(s) of claim(s) 4 and 16 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Englman and Singer.

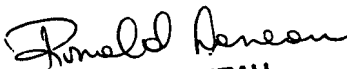
Regarding the applicant's arguments of the combination of Englman and Kaminkow (pages 12-13 of applicant's remarks filed 05/17/2007), the examiner respectfully disagrees. Kaminkow discloses different behaviors for triggered symbol changes (i.e. number of changing symbols randomly selected, changing symbols randomly selected, changing symbols are those displayed when the evolution trigger occurs). The rejections have been further explained above.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin W. Lee whose telephone number is 571-270-1346. The examiner can normally be reached on Mon - Fri (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RONALD LANEAU
PRIMARY EXAMINER
7/23/07

BWL
Benjamin W. Lee
July 23, 2007